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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLIN, CARL G

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/844,924	SKINNER, CRAIG S.	
	Examiner	Art Unit	
	Carl Colin	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/2006 has been entered.

### ***Response to Arguments***

2. In response to communications filed on 7/25/2006, applicant has amended claims 1, 13, and 20. The following claims 1-31 are presented for examination.

3. Applicant's remarks, pages 11-13, filed on 6/26/2006, with respect to the rejection of claims 1-31 have been fully considered, but they are not persuasive. Applicant has amended the independent claims to recite "a single" encrypted record containing "only" a copied serial number and a first authorization level. Although the scope of the claims has changed in view of the amendment, the fact that the items being encrypted in the record are limited to two does not make the claimed invention distinctly patentable over the prior art because an extra item would not affect the claimed method. In addition, Beetcher discloses a single encrypted entitlement key containing only a serial number and entitlement bits that meets the recitation of single encrypted record containing only a serial number and a first authorization level as shown below.

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"The key includes the serial number of the computer for which the software is licensed, together with a plurality of entitlement bits indicating which software modules are entitled to run on the machine." (see abstract)

Applicant mentions that the claimed invention is different from the prior art because the prior art discloses more "fields or bits" of data than the claimed invention. Examiner would like to clarify that the claimed serial number and authorization level of the claimed invention when read by the computer represent also many fields of data and bits of information. Therefore, applicant has not overcome the rejection by amending the claims, and claims 1-31 remain rejected in view of the prior art.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,497 to **Beetcher et al.** in view of US Patent 6,526,512 to **Siefert et al.**

As per claims 1 and 20, **Beetcher et al.** discloses a method of security comprising the steps of: enabling a computer system to execute a software module with an encrypted entitlement key containing a serial number and entitlement bits that meets the recitation of a) enabling an electronic device to run a controlled application with a single encrypted record containing only a copied serial number and a first authorization level, for example (see abstract); **Beetcher et al.** discloses that each customer receives an entitlement key enabling the customer to run only those software modules to which he is entitled (column 4, lines 40-45) that meets the recitation of wherein said first authorization level authorized said electronic device to run controlled applications having authorization levels not exceeding said first authorization level. **Beetcher** also discloses other entitlements such as charge group, key type, serial number of the machine, and product entitlement field assigned to the device (see column 6, lines 20-40). In another embodiment, **Beetcher** discloses in column 7, lines 1-16, other authorization levels that are hardware specific assigned to said electronic device. There is suggestion in column 2, lines 49-53 that other entitlement may also be machine specific entitlement or authorization level assigned to a machine to make sure that a software is authorized to run on a specific machine. b) verifying said electronic device is correctly enabled, for example (see column 6, line 65 through column 7, line 47); and c) verifying said first authorization level is of sufficient authority to run said controlled application on said electronic device, for example (see column 6, line 65 through column 7, line 47); and wherein a second authorization level of said controlled application does not exceed the first authorization level (column 7, lines 1-65). **Beetcher et al** suggests to add protection by using entitlement that contains machine specific information and encoding it into the software itself. **Siefert et al.** in an analogous art teaches key codes containing authorization

levels (column 2, lines 40-65) and the key codes (authorization levels) are assigned to an electronic device and authorizes said electronic device to run controlled applications having authorization levels not exceeding said first authorization level (see column 4, line 44 through column 5, line 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Beetcher et al** to include the step of wherein the first authorization level is assigned to the electronic device and authorizes the electronic device to run controlled applications having authorization levels not exceeding the first authorization level as taught by **Siefert et al** (see column 4, line 44 through column 5, line 55). One of ordinary skill in the art would have been motivated to do so because the teaching of **Siefert** provides detecting and controlling any program that is required to pass the security process by doing the following: when a program launch is requested, running a key code process of comparing the key code of the computer with that of the program to be run in order to authorize execution of the program upon meeting predetermined criteria. One of ordinary skill in the art would have recognized the advantage of preventing hacker from learning the identities of the key codes and preventing hacker from learning how the security process run by assigning key codes (authorization levels) to both the computer and the program by a match determination process and using region of memory, non-accessible to users to store the key codes (authorization levels) as suggested by **Siefert et al** (column 7, lines 15-25 and column 7, line 50 through column 8, line 35 and column 8, lines 50-67).

**As per claims 2, 14, and 21, Beetcher et al.** discloses the limitation of wherein step a) comprises the steps of: a1) fetching a serial number uniquely associated with said electronic

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device, said serial number located on said electronic device, for example (see column 7, line 47); a2) copying said serial number, forming said copied serial number that is identical to said serial number, for example (see column 6, lines 20-40); a3) creating a record that contains said copied serial number and said first authorization level, said first authorization level previously assigned to said electronic device, for example (see column 6, lines 20-40); a4) encrypting said record, forming said encrypted record, for example (see column 4, lines 57-65 and column 8, lines 53-65); and a5) storing said encrypted record in said electronic device, for example (see column 8, lines 53-65). These claims are also rejected on the same rationale as the rejection of claim 1 for reciting "said first authorization level previously assigned to said electronic device".

**As per claims 3 and 22, Beetcher et al.** discloses the limitation of wherein step b) comprises the steps of: b1) locating said encrypted record, for example (see column 9, line 40 through column 10, line 20); b2) decrypting said encrypted record, if said encrypted record is located, for example (see column 9, line 40 through column 10, line 20); b3) reading said copied serial number from said encrypted record, if said encrypted record is successfully decrypted; b4) fetching said serial number, for example (see column 9, line 40 through column 10, line 20); and b5) comparing said serial number and said copied serial number, for example (see column 9, line 40 through column 10, line 20 and column 13, lines 1-8).

**As per claims 4 and 23, Beetcher et al.** discloses the limitation of wherein step b) comprises the further step of executing said controlled application on said electronic device, said controlled application having controlled attributes, for example (see column 6, lines 40-67);

As per claims 5, 12, 24, and 31, the combination of **Beetcher et al** and **Siefert et al** discloses the limitation of wherein said step c) comprises the steps of: c1) reading said first authorization level from said encrypted record that is decrypted, if said serial number and said copied serial number match, for example (see **Beetcher et al**, column 9, lines 40-67 and column 10, lines 20-67); c2) comparing said first authorization level with a second authorization level assigned to said controlled application (**Beetcher et al**, column 10, lines 40-4 and column 7); and c3) allowing access to said controlled attributes of said controlled application, if said first authorization level is of an equal or higher authorization level than said second authorization level, for example (see **Beetcher et al**, column 10, lines 20-47 and column 4, lines 34-46). **Siefert et al** also discloses comparing first authorization level with second authorization level to authorize the computer to run controlled applications as discussed in claim 1. Therefore, these claims are also rejected on the same rationale as the rejection of claim 1.

As per claims 6, 15, and 25, **Beetcher et al** discloses the limitation of wherein step a) is performed with object code instructions that meet the recitation of an enabler application, said enabler application enabling said electronic device to run applications having authorization levels equal to or lower than said first authorization level, for example (see column 8, lines 48-67 and column 4, lines 34-46).

As per claims 8, 9, 18, 19, 27, and 28, the combination of **Beetcher et al** and **Siefert et al** discloses the limitation of comprising the further step of: aborting said application and



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denying access if any of the following conditions are met: said encrypted record is not successfully located in step b1) ; said encrypted record is not successfully decrypted in step b2); said serial number and said copied serial number do not match in step b5); or said first authorization level is of a lesser value than said second authorization level in step c2) , for example (see **Beetcher et al**, column 8, lines 48-67 and column 4, lines 34-46 and column 10, lines 20-67).

**Claims 13 and 16** contain some of the limitations of the rejected **claims 1-5**. Therefore, **claims 13 and 16** are rejected on the same rationale as the rejection of **claims 1-5**.

As per **claim 17**, **Beetcher et al.** discloses the limitation of wherein the same encryption/decryption protocol is used in performing steps c) and m), for example (see column 13, lines 5-18).

As per **claims 7 and 26**, **Beetcher et al.** substantially teaches the claimed method of **claims 6 and 25**. **Beetcher et al.** does not explicitly teach removing said enabler application from said electronic device after successfully completing step a). However, **Siefert et al.** in an analogous art teaches control access to enhance security of resources where a match determination process can take actions of erasing part or all of the program to defeat running of the program, for example (see column 7, lines 35-40). **Siefert et al.** also adds, hiding process/codes or removing or placing them in separate memory or non-accessible memory locations can prevent hackers to trace the logic of codes, for example (see column 7, line 40

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through column 8, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Beetcher et al.** to remove said enabler application from said electronic device after successfully completing step a) as taught by **Siefert et al.** One skilled in the art would have been lead to make such a modification because it would make the security process non accessible to hackers, as suggested by **Siefert et al** for example (see column 7, line 40 through column 8, line 35).

As per claims 10-11 and 29-30, **Beetcher et al.** discloses locking in memory the version number the product number, serial number etc. and also discloses codes stored in read-only memory (ROM) to make it not capable of alteration by customers, for example (see column 7, lines 15-30 and column 9, lines 49-67). It is well known in the art of computer security that computers have flash memory and using a flash memory will not depart from the spirit and scope of the invention of **Beetcher et al.** **Siefert et al.** also discloses using read-only memory (ROM) for the encrypted data and serial number. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store said encrypted record and serial number in locked flash record in said electronic device as suggested by **Beetcher et al.** One skilled in the art would have been lead to make such a modification to prevent alteration of these data by customers.

*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cc

Carl Colin  
Patent Examiner  
September 20, 2006

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9/20/06